

Appl. No. : 09/698507
Filed : October 26, 2000

REMARKS

By this paper, Claim 25 has been amended. Claims 61-70 have been amended and renumbered. Claims 1-24 and 26-60 remain unchanged. Thus, Claims 1-70 remain pending in the application and are presented for further examination.

I. Objection to Specification

In paragraph 2 of the Office Action, the Examiner objected to page 3, line 24 of the specification for reciting “exits” rather than “exists.” Applicant has amended the specification accordingly.

In paragraph 3 of the Office Action, the Examiner objected to the number of the claims. In particular, the Examiner indicated that Claims 62-71 should be renumbered as 61-70. Applicant has amended the claims accordingly.

II. Rejection of Claims 1-37 under 35 U.S.C. § 103(a)

In paragraph 5 of the Office Action, the Examiner rejected Claims 1-37 as being unpatentable over U.S. Patent Number 6,508,709 to Karmarkar in view of U.S. Patent No. 6,767,825 to MacKenzie, et al. (“MacKenzie”). On page 12 of the Office Action, the Examiner rejected Claims 38-48 under 35 U.S.C. § 103(a) as being unpatentable over Karmarkar in view of U.S. Patent No. 6,370,249 to Van Oorscot. On page 16 of the Office Action, the Examiner rejected Claims 49-60 and Claims 62-71 (now Claims 61-70) under 35 U.S.C. § 103(a) as being unpatentable over Karmarkar in view of U.S. Patent No. 6,711,264 to Matsumoto, et al.

Applicant respectfully disagrees. However, as Applicant has filed with this response Declarations by Rolf Carson, Robert Dorr, and John Thompson, under 37 C.F.R. § 1.131 that Applicant believes removes the Karmarkar and MacKenzie references from consideration, Applicant has not presented arguments in support of the patentability of these claims.

The *Declarations* includes facts showing a completion of the invention in this country before the filing date of the application on which the domestic patent issued (37 C.F.R. § 1.131(a)(1) and M.P.E.P. § 715). The showing of facts are such, in character and weight, as to establish conception of the invention prior to the effective date of the reference coupled with due diligence from a date prior to the effective date of the reference to a subsequent filing of the application (37 C.F.R. § 1.131(b) and M.P.E.P. § 715).

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Applicant notes that Karmarkar was filed on June 18, 1999 and MacKenzie on July 13, 1999. The critical date to remove both applications from consideration is thus June 18, 1999.

The features of the invention as recited in independent Claims 1-70 were conceived at least prior to June 18 in this country. The *Declaration* by Rolf Carlson shows that a paper describing the invention was provided to the assigned attorneys, Mr. Dorr and Mr. Thompson, prior to June 18, 1999. Applicant submits that Carlson paper shows conception of the claimed invention prior to the critical date. These facts establish that the inventors had conceived of the invention as early as June 18, 1999.

Additionally, reasonable due diligence in reducing the invention to constructive reduction to practice was made from at least prior to June 18, 1999 to at least October 26, 1999, the filing date of the priority application to the present patent application. Rolf Carlson states that the invention was diligently reduced to practice therefrom until the filing of the priority application (U.S. Provisional Patent No. 60/161,591) of the present application on October 26, 1999. In addition, the diligence of the attorney in preparing and filing the patent application inures to the benefit of the inventor. See *Bey v. Kollonitsch*, 866 F.2d 1024, 231 USPQ 967 (Fed. Cir. 1986) (Reasonable diligence is all that is required of the attorney. Reasonable diligence is established if the attorney worked reasonably hard on the application during the continuous critical period. It is not necessary that the attorney should drop all other work and concentrate on the particular invention involved. If the attorney has a reasonable backlog of unrelated cases which he takes up in chronological order and carries out expeditiously, that is sufficient.). The *Declarations* by Mr. Dorr and Mr. Thompson show they met the requisite diligence with respect to progress on the application during from at least prior to June 18, 1999 to at least October 26, 1999.

In his Declaration, Mr. Dorr, a prosecuting attorney for the application, states that the invention claimed in the present application was conceived at least prior to June 18, 1999 and was diligently reduced to practice therefrom until the filing of the present application on October 26, 1999. In addition, Mr. Thompson, also a prosecuting attorney for the application, states that the invention claimed in the present application was conceived at least prior to June 18, 1999 and was diligently reduced to practice therefrom until the filing of the present application on October 26, 1999. As stated in each of these declarations, Mr. Thompson spent at least 170 hours working on the priority application between April and September 1999. Applicant has included

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with the Exhibits A, B, C, and D to the Carlson Declaration, Exhibits A and B to the Dorr Declaration, and Exhibits A, B, and C to the Thompson Declaration, which corroborate the declarations to show conception prior to June 18, 1999 and diligent reduction to practice therefrom.

Consequently, Applicant respectfully submits that Karmarkar and MacKenzie are not available as a prior art reference under 35 U.S.C. § 103(a). Furthermore, since Karmarkar was the primary reference relied upon in the Office Action, Applicant respectfully submits that the Examiner has failed to provide a valid prima facie rejection. Accordingly, Applicant submits that each of Claims 1-70 is in condition for allowance.

III. Conclusion

Applicant has endeavored to address all of the Examiner's concerns as expressed in the Office Action. Accordingly, amendments to the claims, the reasons therefor, and arguments in support of patentability of the pending claim set are presented above. Any claim amendments which are not specifically discussed in the above remarks are made in order to improve the clarity of claim language, to correct grammatical mistakes or ambiguities, and to otherwise improve the clarity of the claims to particularly and distinctly point out the invention to those of skill in the art. Finally, Applicant submits that the claim limitations above represent only illustrative distinctions. Hence, there may be other patentable features that distinguish the claimed invention from the prior art.

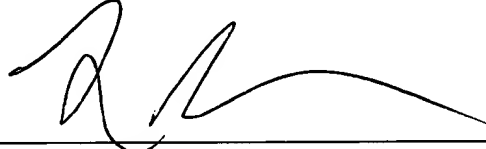
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In view of the foregoing, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejections and, particularly, that all claims be allowed. If the Examiner finds any remaining impediment to the prompt allowance of these claims that could be clarified with a telephone conference, the Examiner is respectfully invited to call the undersigned. Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

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By: 
John Rickenbrode
Registration No. 57,067
Attorney of Record
Customer No. 20,995
(619) 235-8550

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